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From: Michele Morrow Legal Assistant to Gerald H. Glanzman	No. of Pages Including Cover Sheet: **38**

Message:

Enclosed herewith:

- Transmittal Document; and
- Appeal Brief.

Re: Application No. **10/045,111**
Attorney Docket No: **AUS920010994US1**

Date: Monday, June 13, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Berry**

Serial No.: **10/045,111**

Filed: **January 10, 2002**

For: **Method and Apparatus for Automatic Pruning of Search Engine Indices**

35525
PATENT TRADEMARK OFFICE CUSTOMER NUMBER

§ Group Art Unit: **2161**
§
§ Examiner: **Nguyen, Cam Linh T.**
§
§ Attorney Docket No.: **AUS920010994US1**
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By: Michele Morrow
Michele Morrow

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- Appeal Brief (37 C.F.R. 41.37).

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Docket No. AUS920010994US1 *PATENT*

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Examiner: **Nguyen, Cam Linh T.**

Commissioner for Patents
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By: Michele Morrow
Michele Morrow

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on April 13, 2005.

The fees required under § 41.20(B)(2), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-46

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: NONE
2. Claims withdrawn from consideration but not canceled: NONE
3. Claims pending: 1-46
4. Claims allowed: NONE
5. Claims rejected: 1-46
6. Claims objected to: NONE

C. CLAIMS ON APPEAL

The claims on appeal are: 1-46

STATUS OF AMENDMENTS

An Amendment after Final Rejection was not filed. Therefore, claims 1-46 on appeal herein are as amended in the Response to Office Action filed September 21, 2004, and as finally rejected on January 14, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER

A. CLAIM 1 - INDEPENDENT

The subject matter of claim 1 is directed to a method in a data processing system for pruning search engine indices. A notification is received by a search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords (Step **900, Figure 9**, page 21, lines 6-7, also see page 17, lines 4-7). The Web page is automatically deleted from the search engine indices in response to receiving the notification (Step **906, Figure 9**, page 21, lines 15-18, also see page 17, lines 7-10).

B. CLAIM 8 - INDEPENDENT

The subject matter of claim 8 is directed to a method in a data processing system for managing entries in a Web page database. A notification is received by a search engine from a client browser that a retrieval error occurred for a Web page (Step **900, Figure 9**, page 21, lines 6-7, also see page 17, lines 4-7). An entry associated with the Web page is automatically deleted from the Web page database in response to receiving the notification (Step **906, Figure 9**, page 21, lines 15-18, see also page 17, lines 7-10).

C. CLAIM 13 – INDEPENDENT

The subject matter of claim 13 is directed to a method in a data processing system for removing a faulty entry from an index of Web pages. A result is received from a server, wherein the result includes links to Web pages corresponding to a search request (Step **700, Figure 7**, page 18, lines 17-20). A Web page identified by a link in the links is requested in response to a user input selecting the link (Step **704, Figure 7**, page 18, lines 21-22), and a notification is sent to the server in response to an error occurring in retrieving the Web page (Step **714**, page 19, lines 9-11).

D. CLAIM 16 – INDEPENDENT

The subject matter of claim 16 is directed to a method in a data processing system for managing a set of bookmarks for a browser. A request for a Web page is sent in response to a selection of a bookmark from the set of bookmarks, wherein the bookmark is associated with the Web page (Steps **1000** and **1002, Figure 10**, page 22, lines 23-25). A determination is made whether an error has occurred in retrieving the Web page (Step **1004, Figure 10**, page 22, lines 25-27) and the bookmark is removed in response to determining that an error has occurred in retrieving the Web page (Step **1014, Figure 10**, page 23, lines 4-7).

E. CLAIM 20 – INDEPENDENT

The subject matter of claim 20 is directed to a data processing system for pruning search engine indices. The data processing system (**200, Figure 2**, page 9, lines 21-25) comprises a bus system (including busses **206, 212** and **216, Figure 2**, page 9, line 25- page 10, line 11) , a communications unit connected to the bus system (modem **218** and network adapter **220, Figure 2**, page 10, lines 9-11), a memory (**209, Figure 2**, page 9, lines 29-31) connected to the bus system that includes a set of instructions, and a processing unit (**202, 204, Figure 2**, page 9, lines 27-28) connected to the bus system that executes the set of instructions to receive a notification from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords (page 16, lines 6-16). The processing unit automatically deletes the Web page from the search engine indices in response to receiving the notification (page 17, lines 4-10).

F. CLAIM 21 – INDEPENDENT

The subject matter of claim 21 is directed to a data processing system for managing entries in a Web page database. The data processing system (**200, Figure 2**, page 9, lines 21-25) comprises a bus system (including busses **206, 212** and **216, Figure 2**, page 9, line 25- page 10, line 11), a communications unit connected to the bus system (modem **218** and network adapter **220, Figure**

2, page 10, lines 9-11), a memory (209, Figure 2, page 9, lines 29-31) connected to the bus system that includes a set of instructions, and a processing unit (202, 204, Figure 2, page 9, lines 27-28) connected to the bus system that executes the set of instructions to receive a notification by a search engine (506, Figure 5, page 15, line 13) from a client browser (506, Figure 5, page 15, lines 8-9) that a retrieval error occurred for a Web page (page 16, lines 6-16). The processing unit automatically deletes an entry associated with the Web page from the Web page database in response to receiving the notification (page 17, lines 4-10).

G. CLAIM 22 – INDEPENDENT

The subject matter of claim 22 is directed to a data processing system for removing a faulty entry from an index of Web pages. The data processing system (200, Figure 2, page 9, lines 21-25) comprises a bus system (including busses 206, 212 and 216, Figure 2, page 9, line 25- page 10, line 11), a communications unit (modem 218 and network adapter 220, Figure 2, page 10, lines 9-11) connected to the bus system, a memory (209, Figure 2, page 9, lines 29-31) connected to the bus system that includes as set of instructions, and a processing unit (202, 204, Figure 2, page 9, lines 27-28) connected to the bus system that executes the set of instructions to receive a result from a server, the result including links to Web pages corresponding to a search request; requests a Web page identified by a link in the links in response to a user input selecting the link; and sends a notification to the server in response to an error occurring in retrieving the Web page (page 17, lines 4-8).

H. CLAIM 23 – INDEPENDENT

The subject matter of claim 22 is directed to a data processing system for managing a set of bookmarks for a browser. The data processing system (200, Figure 2, page 9, lines 21-25) comprises a bus system (including busses 206, 212 and 216, Figure 2, page 9, line 25- page 10, line 11), a communications unit (modem 218 and network adapter 220, Figure 2, page 10, lines 9-11) connected to the bus system, a memory (209, Figure 2, page 9, lines 29-31) connected to the bus system that includes a set of instructions, and a processing unit (202, 204, Figure 2, page

9, lines 27-28) connected to the bus system that executes the set of instructions to send a request for a Web page in response to a selection of a bookmark from the set of bookmarks in which the bookmark is associated with the Web page, and removes the bookmark in response to determining that an error has occurred in retrieving the Web page (page 22, line 23-page 23, line 7)

I. CLAIM 24 – INDEPENDENT

The subject matter of claim 24 is directed to a data processing system for pruning search engine indices. The data processing system (**200, Figure 2**, page 9, lines 21-25) comprises first means (**202, 204, Figure 2**, page 9, lines 27-28) for receiving a notification from a client browser (**502, Figure 5**, page 15, line 8-9) that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords, and deleting means for automatically deleting the Web page from the search engine indices in response to receiving the notification (**202, 204, Figure 2**, page 9, lines 27-28).

J. CLAIM 31 – INDEPENDENT

The subject matter of claim 31 is directed to a data processing system for managing entries in a Web page database. The data processing system (**200, Figure 2**, page 9, lines 21-25) comprises receiving means (**202, 204, Figure 2**, page 9, lines 27-28) for receiving a notification from a client browser that a retrieval error occurred for a Web page, and deleting means (**202, 204, Figure 2**, page 9, lines 27-28) for automatically deleting an entry associated with the Web page from the Web page database in response to receiving the notification.

K. CLAIM 36 – INDEPENDENT

The subject matter of claim 36 is directed to a data processing system for removing a faulty entry from an index of Web pages. The data processing system (**300, Figure 3**, page 11, lines 2-5) comprises receiving means (**302, Figure 3**, page 11, lines 11-14) for receiving a result from a

server, wherein the result includes links to Web pages corresponding to a search request, requesting means for requesting a Web page identified by a link in the links in response to a user input selecting the link, and sending means (**302, Figure 3**, page 11, lines 11-14) for sending a notification to the server in response to an error occurring in retrieving the Web page.

L. CLAIM 39 – INDEPENDENT

The subject matter of claim 39 is directed to a data processing system for managing a set of bookmarks for a browser. The data processing system (**300, Figure 3**, page 11, lines 11-14) comprises sending means (browser **400, Figure 4**. page 22, lines 18-25) for sending a request for a Web page in response to a selection of a bookmark from the set of bookmarks, wherein the bookmark is associated with the Web page, determining means (browser **400, Figure 4**. page 22, lines 25-30) for determining whether an error has occurred in retrieving the Web page, and removing means (browser **400, Figure 4**, page 22, line 31 –page 23, line 9) for removing the bookmark in response to determining that an error has occurred in retrieving the Web page.

M. CLAIM 43 – INDEPENDENT

The subject matter of claim 43 is directed to a computer program product in a computer readable medium for pruning search engine indices. The computer program product comprises first instructions for receiving by a search engine a notification from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords (Step **900, Figure 9**, page 21, lines 6-7, also see page 17, lines 4-7), and second instructions for automatically deleting the Web page from the search engine indices in response to receiving the notification (Step **906, Figure 9**, page 21, lines 15-18, also see page 17, lines 7-10).

N. CLAIM 44 – INDEPENDENT

The subject matter of claim 44 is directed to a computer program product in a computer readable

medium for managing entries in a Web page database. The computer program product comprises first instructions for receiving by a search engine a notification from a client browser that a retrieval error occurred for a Web page (Step **900, Figure 9**, page 21, lines 6-7, also see page 17, line 9 –page 18, line 10), and second instructions for automatically deleting an entry associated with the Web page from the Web page database in response to receiving the notification (Step **906, Figure 9**, page 21, lines 15-18).

O. CLAIM 45 – INDEPENDENT

The subject matter of claim 45 is directed to a computer program product in a computer readable medium for removing a faulty entry from an index of Web pages. The computer program product comprises first instructions for receiving a result from a server, wherein the result includes links to Web pages corresponding to a search request (Step **700, Figure 7**, page 18, lines 17-20), second instructions for requesting a Web page identified by a link in the links in response to a user input selecting the link (Step **704, Figure 7**, page 18, lines 21-22), and third instructions for sending a notification to the server in response to an error occurring in retrieving the Web page (Step **714**, page 19, lines 9-11).

P. CLAIM 46 – INDEPENDENT

The subject matter of claim 46 is directed to a computer program product in a computer readable medium for managing a set of bookmarks for a browser. The computer program product comprises first instructions for sending a request for a Web page in response to a selection of a bookmark from the set of bookmarks, wherein the bookmark is associated with the Web page (Steps **1000** and **1002, Figure 10**, page 22, lines 23-25), second instructions for determining whether an error has occurred in retrieving the Web page (Step **1004, Figure 10**, page 22, lines 25-27), and third instructions for removing the bookmark in response to determining that an error has occurred in retrieving the Web page (Step **1014, Figure 10**, page 23, lines 4-7).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. GROUND OF REJECTION 1 (Claims 1-15, 20-22, 24-38 and 43-45)

Claims 1-15, 20-22, 24-38 and 43-45 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Glass et al. (U.S. Patent No. 6,253,204) in view of Jakob Nielsen (U.S. Patent No. 6,658,662).

B. GROUND OF REJECTION 2 (Claims 16-19, 23, 39-42 and 46)

Claims 16-19, 23, 39-42 and 46 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Glass et al. (U.S. Patent No. 6,253,204) in view of Jakob Nielsen (U.S. Patent No. 6,658,662) and further in view of Li et al. (U.S. Patent No. 6,631,496).

ARGUMENT

A. GROUND OF REJECTION 1 (Claims 1-15, 20-22, 24-38 and 43-45)

Claims 1-15, 20-22, 24-38 and 43-45 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Glass et al. (U.S. Patent No. 6,253,204) in view of Jakob Nielsen (U.S. Patent No. 6,658,662).

In rejecting claims 1, 8, 13, 20-22, 24, 31, 36 and 43-45 the Examiner states the following:

> Glass et al discloses a method in a data processing system for pruning search engine indices, comprising:
> - "Receiving a notification by a search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords" See Fig. 2-3, col. 4, lines 24-col. 5, lines 20. In particular, Glass teaches that a user requests a document such as "document 1" from the Web. The request that contains "document 1" is inputted to the browser. Therefore, "document 1" corresponds to a keyword. After that "document 2" is also another keyword, when the user tries to retrieve it. The user is notified if the file is not found, and the browser automatically generates a message to send to the server (fig. 3, step 340). Glass also teaches that a spider can be utilized (see the abstract). By definition of Microsoft Computer dictionary, Fifth Edition, the term "spider" is an automated program that searches the Internet for documents and indexes their addresses and content related information in a database and also called search engine or crawler. Therefore, this spider is considered equivalent with the "search engine" in the instant application. Since it is a program, the spider can be located in the server side of the system or client side or in the middle such as central system to search for information in the network. A client reports the broken link to the server in which a spider located (as discussed above) (see col. 7, lines 15-16, 57-59).
>
> Glass teaches that the server will modify the broken link in order to restore the link.
>
> Glass does not clearly teach that the system will 'automatically deleting the Web page from the search engine indices in response to receiving the notification". Glass teaches that the server will modify the broken link in order to restore the link. However, Jakob Nielsen discloses a retrieving information system that allows a user view a website at a remote server (col. 8, lines 7-8). As seen in Fig. 4B, a URL list is generated and the system attempts to connect with a website server. The system has a capability of deleting the URL if an error occurs (col. 8, lines 65-col. 9, lines 3). One with skill in the art would recognize that the list could be represented as an index in the search engine.
>
> It would have been obvious to one with ordinary skill in the art at the time the

invention was made to modify the system of Glass by applying the teaching of Nielsen for deleting the web page if not found because the combination would reduce the time/cost searching for other user in later time.

Final Office Action dated January 14, 2005, pages 2-3..

Claim 1 on appeal herein is as follows:

1. A method in a data processing system for pruning search engine indices, the method comprising:
receiving a notification by a search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords; and
automatically deleting the Web page from the search engine indices in response to receiving the notification.

A fundamental notion of patent law is the concept that invention lies in the new combination of old elements. Therefore, a rule that every invention could be rejected as obvious by merely locating each element of the invention in the prior art and combining the references to formulate an obviousness rejection is inconsistent with the very nature of "invention." Consequently, a rule exists that a combination of references made to establish a *prima facie* case of obviousness must be supported by some teaching, suggestion, or incentive contained in the prior art which would have led one of ordinary skill in the art to make the claimed invention.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The requirements for establishing a *prima facie* case of obviousness in view of a combination of references are set forth in detail in Section 2142 of the MPEP and include the requirements that the Examiner explain in detail why the combination of the teachings is proper, that the Examiner provide a clear and convincing line of reasoning as to why an artisan would have found the claimed invention obvious in light of the teachings of the references, and that the Examiner provide a showing that it is the prior art and not the Applicant's own disclosure that teaches the combination asserted by the Examiner.

Appellant respectfully submits that the Examiner has not established a *prima facie* case of obviousness in rejecting claims of the present application as being obvious over Glass et al. in

view of Jakob Nielsen, and that the claims are allowable over the references in their present form.

Initially, Appellant submits that neither Glass et al. (hereinafter "Glass") nor Jakob Nielsen (hereinafter "Nielsen") discloses or suggests a method "for pruning search engine indices" as indicated by the Examiner. Furthermore, Appellant submits that neither Glass nor Nielsen, considered alone or in combination, discloses or suggests "automatically deleting the Web page from the search engine indices" in response to "receiving a notification by a search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords" as required by claim 1.

Glass discloses a technique to provide information to a user about the status of information links, such as hypertext links, found in network-based documents. In Glass, a user downloads a document 1 that contains a hypertext link to a document 2. The user then attempts to retrieve document 2, for example, by double clicking on the hypertext link; and an attempt is made to connect with the server where document 2 is located. If document 2 is not available, the link is considered broken. If the link is broken, a mechanism is provided to change the presentation of document 2 on document 1 to indicate that there is a broken link to document 2. The presentation can be changed, for example, by changing the color of the HTML code associated with the information link, by putting an icon before and/or after the information link, or the like (see col. 5, lines 48-57 of Glass).

The Examiner refers specifically to step 340 in Figure 3 of Glass as disclosing "receiving a notification from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords". Col. 5, lines 12-19 of Glass reads as follows:

> The network address of the user (or client) which receives the file not found error message is placed in the source address field of the message format of Fig. 4 (330). Then a broken link message is sent to the site which originated the page containing the broken link (340). Preferably, broken link information is concurrently stored in a broken link database such as that shown in FIG. 6 (emphasis added).

This recitation does not disclose that a notification is received by a search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no

longer contains selected keywords as is required in claim 1. Instead, the notification in Glass is sent to the site which originated the page containing the broken link, i.e., the site for document 1, not to the site of the unavailable document 2.

Glass nowhere discloses "receiving a notification by a search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords" as required by claim 1. Even if a spider can be utilized in the system disclosed in Glass, as noted by the Examiner, Glass would still not disclose "receiving a notification by a search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords".

Additionally, and as recognized by the Examiner, Glass also does not disclose "automatically deleting the Web page from the search engine indices in response to receiving the notification" as recited in claim 1. The Examiner indicates, however, that Nielsen discloses a capability of deleting a URL if an error occurs, and refers to col. 8, line 65 to col. 9, line 3 of Nielsen as disclosing this feature.

Col. 8, line 65 to col. 9, line 3 of Nielsen reads as follows:

> Upon completion of the parsing operation, the system 2 reads each URL in the URL list 30 and attempts to connect to the website identified in the URL through the Internet 50. This is done by issuing the HTTP GET command, with the URL as an argument. If the domain name of the server included in the URL is not listed in the DNS, or if no server at the URL responds within a pre-determined timeout period (such as 30 seconds), an error condition is raised and the URL is deleted from the URL list 30.

Nielsen is directed to capturing information from a broadcast signal for later use. In particular, Nielsen is concerned with a broadcast signal that identifies a URL that a viewer may want to later access. Nielsen recognizes that the viewer may not have time to write down the URL for future use, and provides a mechanism for storing an image from the broadcast signal that contains the URL so that it may be later retrieved.

In Nielsen, a list of several strings of text, that might be a URL, may be recognized from a video image, and a list of such possible URLs is generated by the system. The system reads the possible URLs from the list and attempts to connect to a website. If the domain name does not exist or if no server responds, the possible URL is deleted from the list.

In Nielson, information recognized as being URLs is deleted from a list that is created by the system to identify and store URLs of possible interest to a viewer of a video broadcast. Nielsen does not disclose or suggest "automatically deleting the Web page from the search engine indices in response to "receiving a notification by a search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords". Nielsen does not disclose deleting a Web page from search engine indices, but only discloses deleting a URL from a created list of possible URLs.

Accordingly, neither Glass nor Nielsen teach or suggest "receiving a notification by a search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords" or "automatically deleting the Web page from the search engine indices in response to receiving the notification", as required in claim 1, and any combination of Glass and Nielsen would not achieve the present invention as recited in claim 1.

There is also no suggestion in either Glass or Nielsen to combine the references as proposed by the Examiner. In fact, it is believed that Glass actually teaches away from the Examiner's proposed combination.

In combining the references, the Examiner states that it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the system of Glass by applying the teaching of Nielsen for deleting the web page if not found because the combination would reduce the time/cost searching for other users in later time. Appellant submits, however, that one of ordinary skill in the art, having both Glass and Nielsen before him would not consider modifying Glass to automatically delete a Web page from search engine indices simply because the user is not able to access the Web page from a hypertext link in a document.

In particular, the objective in Glass is to provide a mechanism to advise a user that downloads a document 1 that a link in document 1 to a document 2 is broken. If the link is later repaired, the user is so advised. Deleting the Web page from search engine indices would appear to preclude later repairing the link. Thus, even if Nielsen could be construed as teaching deleting a Web page from search engine indices, which it does not; doing so in Glass would defeat a major objective in Glass.

Furthermore, in combining the references, it appears that the Examiner assumes that a user has a right to automatically delete a Web page of another party from a search engine index

simply because the user is unable to access the Web page through a particular link. Appellant submits that this is not a reasonable assumption. This is particularly true, as indicated above, since Glass recognizes that the broken link may be repaired at a future time.

Thus, in summary, there is no reasonable basis for combining the references as proposed by the Examiner, and, in addition, even if the references were combined as proposed by the Examiner, the combination would not teach or suggest the present invention as recited in claim 1. Claim 1, accordingly, should be allowable over Glass in view of Nielsen, and it is respectfully requested that the Board so find.

Claims 2-7 depend from and further restrict claim 1 and are also allowable over Glass in view of Nielsen, at least by virtue of their dependency.

Independent claim 8 contains limitations generally similar to claim 1, and should also be allowable over Glass in view of Nielsen in its present form, together with claims 9-12 dependent thereon, for substantially the same reasons as discussed in detail above with respect to claim 1.

Independent claim 13 is as follows:

> 13. A method in a data processing system for removing a faulty entry from an index of Web pages, the method comprising:
> receiving a result from a server, wherein the result includes links to Web pages corresponding to a search request;
> requesting a Web page identified by a link in the links in response to a user input selecting the link; and
> sending a notification to the server in response to an error occurring in retrieving the Web page.

For substantially the same reasons as discussed above with respect to claim 1, neither Glass nor Nielsen teaches or suggests a method for removing a faulty entry from an index of Web pages that includes "sending a notification to the server in response to an error occurring in retrieving the Web page" as recited in claim 13. Claim 13, accordingly, should also be allowable in its present form together with claims 14 and 15 dependent thereon, and it is respectfully requested that the Board so find.

Independent claims 20, 21, 22, 24, 31, 36 and 43-45 recite limitations that are generally similar to claims 1 and 13, and should also be allowable in their present form for similar reasons

as discussed above with respect to claims 1 and 13. Claims 25-30, 32-35, 37 and 38 depend from and further restrict one of claims 24, 31 and 36 and should also be allowable in their present form, at least by virtue of their dependency.

Therefore, the rejection of claims 1-15, 20-22, 24-38 and 43-45 under 35 U.S.C. § 103(a) has been overcome, and it is respectfully requested that the Board reverse the Examiner's final rejection of those claims.

B. GROUND OF REJECTION 2 (Claims 16-19, 23, 39-42 and 46)

Claims 16-19, 23, 39-42 and 46 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Glass et al. (U.S. Patent No. 6,253,204) in view of Jakob Nielsen (U.S. Patent No. 6,658,662) and further in view of Li et al. (U.S. Patent No. 6,631,496).

In rejecting claims 16, 23, 39 and 46, the Examiner states:

> The combination of Glass and Nielson disclose the limitation of determining an error in retrieving the web page, and removing the web page in response to the error. Glass and Nielsen fail to disclose a system for managing a set of bookmarks for browser. However, it is well known in the art, that a user can bookmark an URL for querying in the future. An example is provided by Li et al. Li discloses a system for personalizing and managing web information that includes a hypermedia database for managing bookmark, which allows a user to organize hypertext documents for querying (see the abstract of Li).
>
> It would have been obvious to one with ordinary skill in the art at the time the invention was made to bookmark an URL for later use because it allows the user the capability of managing favorite information without remember it.

Final Office Action dated January 14, 2005, page 5.

Independent claim 16 on appeal herein, is as follows:

> 16. A method in a data processing system for managing a set of bookmarks for a browser, the method comprising:
>
> sending a request for a Web page in response to a selection of a bookmark from the set of bookmarks, wherein the bookmark is associated with the Web page;
>
> determining whether an error has occurred in retrieving the Web page; and

removing the bookmark in response to determining that an error has occurred in retrieving the Web page.

A fundamental notion of patent law is the concept that invention lies in the new combination of old elements. Therefore, a rule that every invention could be rejected as obvious by merely locating each element of the invention in the prior art and combining the references to formulate an obviousness rejection is inconsistent with the very nature of "invention." Consequently, a rule exists that a combination of references made to establish a *prima facie* case of obviousness must be supported by some teaching, suggestion, or incentive contained in the prior art which would have led one of ordinary skill in the art to make the claimed invention.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The requirements for establishing a *prima facie* case of obviousness in view of a combination of references are set forth in detail in Section 2142 of the MPEP and include the requirements that the Examiner explain in detail why the combination of the teachings is proper, that the Examiner provide a clear and convincing line of reasoning as to why an artisan would have found the claimed invention obvious in light of the teachings of the references, and that the Examiner provide a showing that it is the prior art and not the Applicant's own disclosure that teaches the combination asserted by the Examiner.

Appellant respectfully submits that the Examiner has not established a *prima facie* case of obviousness in rejecting claims of the present application as being obvious over Glass and Nielsen in view of Li et al., and that the claims are allowable over the references in their present form.

Initially, as discussed above, Glass and Nielsen do not disclose "removing the Web page in response to the error" as alleged by the Examiner, and Li et al. (hereinafter Li) does not supply the deficiencies in the principal references. Li discloses a hypermedia database for managing bookmarks so that a user can organize hypertext documents for various purposes. Li does not disclose or suggest removing a bookmark "in response to determining that an error has occurred in retrieving the Web page". Claim 16, accordingly, should be allowable in its present form, and it is respectfully requested that the Board so find.

Claims 17-19 depend from and further restrict claim 16 and should also be allowable in their present form, at least by virtue of their dependency.

Independent claims 23, 39 and 46, and dependent claims 40-42 patentably distinguish over the references for substantially the same reasons as discussed above with respect to claim 16, and should also be allowable in their present form.

Therefore, the rejection of claims 16-19, 23, 39-42 and 46 under 35 U.S.C. § 103(a) has been overcome, and it is respectfully requested that the Board reverse the Examiner's final rejection of those claims.

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CLAIMS APPENDIX

The text of the claims involved in the appeal are:

1. A method in a data processing system for pruning search engine indices, the method comprising:

receiving a notification by a search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords; and

automatically deleting the Web page from the search engine indices in response to receiving the notification.

2. The method of claim 1, wherein the step of automatically deleting is initiated if the notification results in a minimum number of notifications being received for the Web page.

3. The method of claim 1 further comprising:

receiving a search request from the client browser, wherein the search request contains the selected keywords;

searching the search engine indices for matches to the selected keywords to form a search; and

sending a result of the search to the client browser.

4. The method of claim 3, wherein the result includes an indication that the data processing system includes a search engine to cause the client browser to send the notification to the data processing system.

5. The method of claim 4, wherein the search request includes other keywords in addition to the selected keywords.

6. The method of claim 1, wherein the retrieval error indicates that the Web page is absent.

7. The method of claim 1, wherein the method is located in one of a search engine or a Web portal.

8. A method in a data processing system for managing entries in a Web page database, the method comprising:

receiving a notification by a search engine from a client browser that a retrieval error occurred for a Web page; and

automatically deleting an entry associated with the Web page from the Web page database in response to receiving the notification.

9. The method of claim 8, wherein the step of automatically deleting the entry occurs only if the notification causes a number of notifications received for the entry to exceed a threshold value.

10. The method of claim 8 further comprising:

receiving a search request from the client browser;

searching the Web page database for matches to the request to generate a result; and

sending the result generated from searching the Web page database to the client browser, wherein the result includes an indicator that the data processing system includes a search engine to cause the client browser to return the notification.

11. The method of claim 8, wherein the notification is a first type of notification and further comprising:

receiving a second type of notification from a client browser that at least one selected search term is absent from the Web page; and

automatically deleting an entry associated with the Web page from the Web page database in response to receiving the second type of notification.

12. The method of claim 8, wherein the method is located in one of a search engine or a Web portal.

13. A method in a data processing system for removing a faulty entry from an index of Web pages, the method comprising:

receiving a result from a server, wherein the result includes links to Web pages corresponding to a search request;

requesting a Web page identified by a link in the links in response to a user input selecting the link; and

sending a notification to the server in response to an error occurring in retrieving the Web page.

14. The method of claim 13 further comprising:

receiving the Web page to form a retrieved Web page; and

sending a notification to the server in response to an absence of selected keywords in the Web page.

15. The method of claim 13, wherein the method is performed by a browser.

16. A method in a data processing system for managing a set of bookmarks for a browser, the method comprising:

sending a request for a Web page in response to a selection of a bookmark from the set of bookmarks, wherein the bookmark is associated with the Web page;

determining whether an error has occurred in retrieving the Web page; and

removing the bookmark in response to determining that an error has occurred in retrieving the Web page.

17. The method of claim 16, wherein determining whether an error has occurred comprises:

determining whether the error has occurred more than a selected number of times; and

wherein removing the bookmark comprises:

removing the bookmark from the set of bookmarks in response to determining that the error has occurred more than the selected number of times.

18. The method of claim 16, wherein removing the bookmark comprises:

automatically removing the bookmark in response to determining that an error has occurred in retrieving the Web page.

19. The method of claim 16, wherein removing the bookmark comprises:

removing the bookmark in response to a user input to remove the bookmark.

20. A data processing system for pruning search engine indices, the data processing system comprising:

a bus system;

a communications unit connected to the bus system;

a memory connected to the bus system, wherein the memory includes a set of instructions; and

a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to receive a notification from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords; and automatically delete the Web page from the search engine indices in response to receiving the notification.

21. A data processing system for managing entries in a Web page database, the data processing system comprising:

a bus system;

a communications unit connected to the bus system;

a memory connected to the bus system, wherein the memory includes a set of instructions; and

a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to receive a notification by a search engine from a client browser that a retrieval error occurred for a Web page; and automatically delete an entry associated with the Web page from the Web page database in response to receiving the notification.

22. A data processing system for removing a faulty entry from an index of Web pages, the data processing system comprising:

a bus system;

a communications unit connected to the bus system;

a memory connected to the bus system, wherein the memory includes as set of instructions; and

a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to receive a result from a server, wherein the result includes links to Web pages corresponding to a search request; request a Web page identified by a link in the links in response to a user input selecting the link; and send a notification to the server in response to an error occurring in retrieving the Web page.

23. A data processing system for managing a set of bookmarks for a browser, the data processing system comprising:

a bus system;

a communications unit connected to the bus system;

a memory connected to the bus system, wherein the memory includes a set of instructions; and

a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to send a request for a Web page in response to a selection of a bookmark from the set of bookmarks in which the bookmark is associated with the Web page and removes the bookmark in response to determining that an error has occurred in retrieving the Web page.

24. A data processing system for pruning search engine indices, the data processing system comprising:

First means for receiving a notification from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords; and

deleting means for automatically deleting the Web page from the search engine indices in response to receiving the notification.

25. The data processing system of claim 24, wherein the means of automatically deleting is initiated if the notification results in a minimum number of notifications being received for the Web page.

26. The data processing system of claim 24 wherein the receiving means is a first receiving means further comprising:

second receiving means for receiving a search request from the client browser, wherein the search request contains the selected keywords;

searching means for searching the search engine indices for matches to the selected keywords to form a search; and

sending means for sending a result of the search to the client browser.

27. The data processing system of claim 26, wherein the result includes an indication that the data processing system includes a search engine to cause the client browser to send the notification to the data processing system.

28. The data processing system of claim 27, wherein the search request includes other keywords in addition to the selected keywords.

29. The data processing system of claim 24, wherein the retrieval error indicates that the Web page is absent.

30. The data processing system of claim 24, wherein the data processing system is located in one of a search engine or a Web portal.

31. A data processing system for managing entries in a Web page database, the data processing system comprising:

receiving means for receiving a notification from a client browser that a retrieval error occurred for a Web page; and

deleting means for automatically deleting an entry associated with the Web page from the Web page database in response to receiving the notification.

32. The data processing system of claim 31, wherein the deleting means is initiated only if the notification causes a number of notifications received for the entry to exceed a threshold value.

33. The data processing system of claim 31 further comprising:

receiving means for receiving a search request from the client browser;

searching means for searching the Web page database for matches to the request to generate a result; and

sending means for sending the result generated from searching the Web page database to the client browser, wherein the result includes an indicator that the data processing system includes a search engine to cause the client browser to return the notification.

34. The data processing system of claim 31, wherein the notification is a first type of notification and the receiving means is a first receiving means and further comprising:

second receiving means for receiving a second type of notification from a client browser that at least one selected search term is absent from the Web page; and

deleting means for automatically deleting an entry associated with the Web page from the Web page database in response to receiving the second type of notification.

35. The data processing system of claim 31, wherein the receiving means and the deleting means are located in one of a search engine or a Web portal.

36. A data processing system for removing a faulty entry from an index of Web pages, the data processing system comprising:

receiving means for receiving a result from a server, wherein the result includes links to Web pages corresponding to a search request;

requesting means for requesting a Web page identified by a link in the links in response to a user input selecting the link; and

sending means for sending a notification to the server in response to an error occurring in retrieving the Web page.

37. The data processing system of claim 36, wherein the receiving means is a first receiving means and further comprising:

second receiving means for receiving the Web page to form a retrieved Web page; and

sending means for sending a notification to the server in response to an absence of selected keywords in the Web page.

38. The data processing system of claim 36, wherein the means is performed by a browser.

39. A data processing system for managing a set of bookmarks for a browser, the data processing system comprising:

sending means for sending a request for a Web page in response to a selection of a bookmark from the set of bookmarks, wherein the bookmark is associated with the Web page;

determining means for determining whether an error has occurred in retrieving the Web page; and

removing means for removing the bookmark in response to determining that an error has occurred in retrieving the Web page.

40. The data processing system of claim 39, wherein the determining means comprises:

determining means for determining whether the error has occurred more than a selected number of times; and

wherein the removing means comprises:

removing means for removing the bookmark from the set of bookmarks in response to determining that the error has occurred more than the selected number of times.

41. The data processing system of claim 40, wherein the removing means comprises:

generating means for generating a user prompt to remove the bookmark in response to determining that the error has occurred more than the selected number of times.

42. The data processing system of claim 41, wherein the removing means comprises:

removing means for removing the bookmark in response to a user input to remove the bookmark.

43. A computer program product in a computer readable medium for pruning search engine indices, the computer program product comprising:

first instructions for receiving by a search engine a notification from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords; and

second instructions for automatically deleting the Web page from the search engine indices in response to receiving the notification.

44. A computer program product in a computer readable medium for managing entries in a Web page database, the computer program product comprising:

first instructions for receiving by a search engine a notification from a client browser that a retrieval error occurred for a Web page; and

second instructions for automatically deleting an entry associated with the Web page from the Web page database in response to receiving the notification.

45. A computer program product in a computer readable medium for removing a faulty entry from an index of Web pages, the computer program product comprising:

first instructions for receiving a result from a server, wherein the result includes links to Web pages corresponding to a search request;

second instructions for requesting a Web page identified by a link in the links in response to a user input selecting the link; and

third instructions for sending a notification to the server in response to an error occurring in retrieving the Web page.

46. A computer program product in a computer readable medium for managing a set of bookmarks for a browser, the computer program product comprising:

first instructions for sending a request for a Web page in response to a selection of a bookmark from the set of bookmarks, wherein the bookmark is associated with the Web page;

second instructions for determining whether an error has occurred in retrieving the Web page; and

third instructions for removing the bookmark in response to determining that an error has occurred in retrieving the Web page.

EVIDENCE APPENDIX

There is no evidence to be presented.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.